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Practitioner's Docket No. 006894.00003

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Charles D. Powell

Application No.: 10/696,906
Filed: 10/30/2003
For: Waterfowl Luring System

Group No.: 3643
Examiner: Kurt C. Rowan

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TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on May 10, 2005.
2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed.

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CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

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Signature

Date: July 8, 2005

MICHAEL E. SELLERS

(type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

small entity	\$250.00
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Appeal Brief fee due	\$250.00
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4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	\$250.00
Extension fee (if any)	\$0.00

TOTAL FEE DUE	\$250.00
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6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$250.00 to Deposit Account No. 50-1971.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1971.

Date:

July 8, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Charles D. Powell)
APPLICATION NO.: 10/696,906)
FILING DATE: October 30, 2003)
TITLE: WATERFOWL)
LURING SYSTEM)
DOCKET NO: 006394.00003)
ART UNIT: 3643)
EXAMINING ATTORNEY: Kurt C. Rowan)
CONFIRMATION NO.: 9238)

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APPELLANT'S BRIEF (37 CFR 41.37)

This brief is in furtherance of the Notice of Appeal filed in this case on May 10, 2005.

The fees required under §1.17(f) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying Transmittal of Appeal Brief.

This brief is transmitted in triplicate.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this document and any document referred to as being attached therein is being deposited with the U.S. Postal Service in an envelope as "First Class Mail" addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on July 8, 2005.

Michael E. Sellers

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This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. ISSUES TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST (37 CFR 41.37 (c)(1)(i))

The real parties in interest in this appeal are the parties named in the caption of this Brief.

II. RELATED APPEALS AND INTERFERENCES (37 CFR 41.37 (c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS (37 CFR 41.37(c)(1)(iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are claims 1-20.

B. STATUS OF ALL THE CLAIMS

1. Claims pending: 1-20.
2. Claims rejected: 1-20.
3. Claims allowed: None.
4. Claims canceled: None
5. Claims withdrawn: None
6. Claims objected to: None

C. CLAIMS ON APPEAL

Claims 1-20 are on appeal.

IV. STATUS OF AMENDMENTS (37 CFR 41.37 (c)(1)(iv))

All amendments have been entered for purposes of appeal. However, “an explanation of how the new or amended claims would be rejected” does not appear to have been included in the Advisory Action dated May 2, 2005. For purposes of this Appeal Brief, Appellant assumes that the rejections contained in the Final Office Action are maintained.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 CFR 41.37(c)(1)(v))

The present invention is concerned with a waterfowl luring apparatus uniquely configured and mechanized to simulate natural directional movement of waterfowl (p. 1, lines 2-4). With regard to Claim 1, the apparatus employs a rotatable platform that is rotated by a motor or other force-generating unit (p. 7, lines 3-5; FIGS. 3, 5, 11 and 12) powered by a power source (p. 8, line 2). One or more decoys are affixed to the platform via support arms (p. 7, lines 6-11) with one end of the support arm attached to the rotatable platform (p. 7, lines 16-17; p. 8, line 3) and the other end of the support arm

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positioned above the rotatable platform and attached to a waterfowl decoy (p. 7, line 18; p. 8, lines 4-5) so that the decoy is moved along a substantially circular path (p. 8, lines 5-6; p. 9, line 19) above the rotatable platform as the platform is rotated by the force-generating unit (p. 7, lines 18-19; FIGS. 2, 3, 5, 6, 11 and 12).

In connection with Claim 16, the waterfowl luring apparatus employs a rotatable platform that is rotated by a motor or other force-generating unit (p. 7, lines 3-5; FIGS. 3, 5, 11 and 12) powered by a power source (p. 8, line 2). One or more decoys are affixed to the platform via support arms (p. 7, lines 6-11) with one end of the support arm attached to the rotatable platform (p. 7, lines 16-17; p. 8, line 3) and the other end of the support arm positioned above the rotatable platform and attached to a waterfowl decoy (p. 7, line 18; p. 8, lines 4-5) so that the decoy is moved along a substantially circular path (p. 8, lines 5-6; p. 9, line 19) above the rotatable platform as the platform is rotated by the force-generating unit (p. 7, lines 18-19; FIGS. 2, 3, 5, 6, 11 and 12). Each of the support arms is flexible and bends when a decoy is attached (p. 7, lines 9-11; p. 8, lines 9-10; p. 10, lines 14-15).

In connection with Claim 19, the waterfowl luring apparatus employs a rotatable platform that is rotated by a motor or other force-generating unit (p. 7, lines 3-5; FIGS. 3, 5, 11 and 12) powered by a power source (p. 8, line 2). One or more decoys are affixed to the platform via support arms (p. 7, lines 6-11) with one end of the support arm attached to the rotatable platform (p. 7, lines 16-17; p. 8, line 3) and the other end of the support arm positioned above the rotatable platform and attached to a waterfowl decoy (p. 7, line 18; p. 8, lines 4-5) so that the decoy is moved along a substantially circular path (p. 8, lines 5-6; p. 9, line 19) above the rotatable platform as the platform is rotated by

the force-generating unit (p. 7, lines 18-19; FIGS. 2, 3, 5, 6, 11 and 12). The force-generating unit is attached to a buoyant housing (p. 8, lines 1-3; p. 9, line 11). Each of the support arms is flexible and bends when a decoy is attached (p. 7, lines 9-11; p. 8, lines 9-10; p. 10, lines 14-15).

VI. ISSUES TO BE REVIEWED ON APPEAL
(37 CFR 41.37(c)(1)(vi))

1. Whether claims 1-7 and 15-17 are unpatentable under 35 USC 103(a) over Caccamo (U.S. Patent No. 3,768,192) in view of Sugimoto (U.S. Patent No. 5,956,880).
2. Whether claims 8-14 and 18-20 are unpatentable under 35 USC 103(a) over Caccamo as modified by Sugimoto as applied to claim 1, and further in view of Porter (U.S. Patent Application Publication No. US 2003/0204983 A1).
3. Whether claims 1-7 and 15-17 are unpatentable under 35 USC 103(a) over Sugimoto in view of Caccamo.
4. Whether claims 8-14 and 18-20 are unpatentable under 35 USC 103(a) over Sugimoto in view of Caccamo as applied to claim 1, and further in view of Porter.

VII. ARGUMENT (37 CFR 41.37 (c)(1)(vii))

Claims 1-7 and 15-17 are patentable over Caccamo in view of Sugimoto.

Claim 1

The patent to Caccamo does not teach or suggest a waterfowl luring apparatus having a rotatable platform, a force-generating unit for rotating the rotatable platform, a power source for powering the force-generating unit to rotate the rotatable platform, one or more support arms attached to the rotatable platform, or a waterfowl decoy attached to the upper end of each support arm and positioned above the rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the

rotatable platform is rotated by the force-generating unit, as specifically called for in Claim 1. Caccamo teaches a totally passive device that uses wind to animate a decoy attached to the end of a flexible arm. The decoys are mounted to one end of the flexible arm with a pivoting type mount that allows the decoy to pivot about a vertical axis in response to wind. The other end of the flexible arm is supported by a pipe driven into the earth. The decoy can bob up and down and pivot about the vertical axis in response to wind, but unlike the claimed invention the decoy cannot circle or fly through the air even when wind is present. When wind is not present, the decoy sits motionless as though suspended in mid-air. Motion of the decoys is at all time completely dependent upon wind conditions – a significant disadvantage of which the present invention does not suffer.

Nor does the '880 patent to Sugimoto cure the many deficiencies of the passive Caccamo device. Sugimoto describes a bird repelling device that uses a motor to rotate a decoy of a raptor to scare off birds like crows and doves. To enhance its scaring effect, the raptor decoy is fitted with blinking red eyes, a permanent magnet or ultrasonic transmitter, and a sound generator. In stark contrast to Sugimoto, the claimed invention operates to lure birds, not scare them. The Sugimoto decoy is attached for rotation to the motor by a suspension wire, and the motor unit is attached to a building by a support member. A reel around which the suspension wire is wound allows the length of the suspension wire to be controlled so as to vary the size of the hemispherical body B (Figure 2). By varying the rotational speed of the motor, the raptor decoy is caused to pass any point on the surface of the hemispherical body. Motor speed and suspension wire length are controlled by a computer so that flying behavior of an actual bird of prey

is simulated. With this arrangement, the birds are prevented from being accustomed to the same flying trajectory pattern of the raptor decoy and the scaring effect of the device is increased. The device further includes a timer or light sensor, the output of which is used to turn off electrical power to the motor, reel, and power distribution panel during nighttime. An infrared sensor is also provided to sense the presence of birds and initiate operation of the device. In all embodiments described by Sugimoto, the flight path of the raptor decoy is limited to points at or below rotary body 6. Thus, Sugimoto does not teach or suggest a waterfowl luring apparatus of any kind, and more particularly does not teach or suggest a waterfowl luring apparatus having one or more support arms for moving waterfowl decoys along a substantially circular path above a rotatable platform as specifically called for in Claim 1.

The Examiner contends that “it would have been obvious to provide the decoy of Caccamo with a rotating platform, a force generating unit and a power source as shown by Sugimoto for the purpose of rotating the decoys in a circle to attract more waterfowl at times when wind and water power is not providing enough power.” Appellant respectfully disagrees. The prior art (not the applicant) must provide the motivation to make the proposed modifications needed to arrive at the claimed invention, and there is no such motivation provided by Caccamo or Sugimoto. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988) Moreover, Courts have held that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggests the “desirability” for the modification. See In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)(“Mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed

invention, obvious unless **desirability** of such modification is suggested by prior art”)[at 1780][Emphasis added] See also In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)(The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.”)[at 1127][Emphasis added] At least one Court has even held that the motivating suggestion must be explicit. See Winner International Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998)[at 1144][“ . . .there must have been some **explicit** teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention.”][Emphasis added]

The modification proposed by the Examiner is certainly not explicitly taught by either Caccamo or Sugimoto, and it is difficult to understand how the conclusion has been reached that these references somehow suggest that the proposed modification is desirable. If anything, both Caccamo and Sugimoto actually teach away from the proposed modification. The principal object of the Caccamo device is “the provision of a simple yet effective means for mounting a conventional and existing decoy in a manner to achieve animated action thereof in accordance with various wind conditions.” (See column 1, lines 47-51) The modification proposed by the Examiner would subvert this principal object of the Caccamo device in at least two ways. First, incorporating Sugimoto’s motorized, computerized, flashing red-eyed, screeching, ultrasonic-transmitting, bird-scaring device into the bird-luring device of Caccamo would complicate the Caccamo device and render it no longer “simple.” Second, motorizing the Caccamo device would mean that it is no longer animated by wind conditions. Clearly,

the Caccamo device contemplates a simple, passive device that uses wind (not motors or computers) to animate the decoy. To animate the decoys with a computer-controlled, multi-speed motor as proposed by the Examiner would be antithetical to the express teachings of Caccamo and render it non-functional with respect to its expressly stated principal object.

The Examiner has stated that the teaching, suggestion or motivation to combine Caccamo and Sugimoto in the proposed manner comes from knowledge generally available to one of ordinary skill in the art. (Final Office Action, page 6, lines 7-8) This is nothing more than a conclusory statement and convenient assumption about what a hypothetical person of ordinary skill would know or do. The Federal Circuit recently held in a non-precedential ruling that generalized claims of what the skilled artisan would have been aware of is insufficient to support obviousness. In re Beasley, No. 04-1225 (Fed. Cir. 2004) Appellant respectfully submits that one of ordinary skill would more likely be motivated to do what is actually taught and suggested by the cited references. Anything beyond that would require inventive thought or hindsight knowledge of Appellant's invention.

Even when the Caccamo and Sugimoto devices are combined, the claimed invention does not result. The Sugimoto device teaches use of a suspension wire to fly a raptor decoy at or below the point at which the wire is attached for rotation by the motor. When the raptor decoy of Sugimoto is replaced by the waterfowl decoy of Caccamo, the waterfowl decoy will also fly at or below the point at which the suspension wire is attached for rotation by the motor. This is clearly different than the claimed invention.

Waterfowl intended to be lured by such a device will more likely be alarmed or scared

because when the decoy is not positioned above the motor attachment point, the motor and other non-luring structure is more readily observable by waterfowl. While this is not a concern in a device that is intended to scare birds, it is certainly a concern for devices that are intended to lure waterfowl (which are easily scared), and neither reference provides any recognition or solution to this problem. Additionally, if the flexible arm and decoy of Caccamo were somehow incorporated into the motorized device described by Sugimoto (and there is no teaching or suggestion whatsoever in either of the references as to why or how this would be done), the result would be a device that scares waterfowl because the decoys of Caccamo are attached to the arms in a way that causes the decoys to pivot about an axis perpendicular to the flexible arm. This would produce a rotating, spinning decoy that is unlike any duck or other waterfowl that Appellant has ever seen fly. In short, substantial non-obvious modification of the combined teachings of these two references would be required to arrive at Appellant's invention as claimed.

There is a further fatal flaw in the rejection in terms of the combinability of Caccamo and Sugimoto. Here, we have one reference, Caccamo, which employs a simple, passive system that uses wind to animate a decoy for the purpose of luring waterfowl (unlike that claimed by Appellant) combined with another reference, Sugimoto, which employs a complex, active system for the purpose of scaring fowl (also unlike that claimed by Appellant). It is apparent that these two references rely on completely divergent approaches as they attempt to invoke completely different solutions for completely different problems. The considerations involved in scaring birds which dictated the approach employed by Sugimoto are totally unlike the considerations which dictated the approach employed by Caccamo for luring birds.

There is no objectively reasonable basis to assert that the person of ordinary skill attempting to solve the myriad of problems associated with a waterfowl luring apparatus would combine only those elements selected by the Examiner from a passive waterfowl-luring device and an active bird-scaring device. This is especially true when the systems are based on fundamentally different solutions to fundamentally different problems. The reference teachings are simply not “obviously” combinable by any stretch of the imagination. Given the lack of any express teaching or even an implicit suggestion to combine and modify these two references in the proposed manner, it appears that hindsight knowledge of Appellant’s invention has been employed.

In response to the above argument, the Examiner has stated “. . .it should be pointed out that a bird scaring device might scare some birds but attract other birds such as birds of prey.” (Final Office Action, p. 6, lines 10-11) Again, the Examiner has made a conclusory, unsupported statement that is based largely, if not totally, on pure conjecture. Birds of prey are solitary hunters and scavengers who operate alone. Unlike waterfowl, birds of prey do not flock. Appellant submits, therefore, that birds of prey would be more prone to avoid the bird of prey decoy described by Caccamo than to be attracted to it.

For the above reasons, Appellant believes that the references do not teach or suggest the modifications of Caccamo that have been made by the Examiner. Claim 1 is therefore believed to be allowable and such action is respectfully requested.

Claim 16

Claim 16 includes all limitations of Claim 1. To avoid repetition, the above arguments with respect to claim 1 are hereby adopted and reasserted against the rejection of claim 16.

Claim 16 adds to the limitations of claim 1 “wherein each of said support arms is flexible and bends when a decoy is attached to the upper end of the support arm.” Although Caccamo teaches attachment of a decoy to a flexible arm, there is no teaching or suggestion to employ the flexible arm of Caccamo into a rotating waterfowl luring apparatus as set forth in claim 16. Claim 16 is therefore allowable over the cited references and such action is respectfully requested.

Claims 2-7, 15 and 17

As further limitations to an allowable claim, claims 2-7, 15 and 17 are allowable and such action is respectfully requested.

Claims 8-14 and 18-20 are patentable over Caccamo as modified by Sugimoto as applied to claim 1, and further in view of Porter.

Claim 19

As discussed above, Caccamo does not teach or suggest a waterfowl luring device having a rotatable platform, a force-generating unit for rotating the rotatable platform, a power source for powering the force-generating unit to rotate the rotatable platform, one or more support arms attached to the rotatable platform, or a waterfowl decoy attached to the upper end of each support arm and positioned above the rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, as specifically called for in claim 19. Additionally, as discussed above, the teachings of Caccamo are inapposite to

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the teachings of Sugimoto, and even if one did make the cited combination in the particular manner proposed by the Examiner, the claimed invention does not result. To avoid duplicating all of the above discussion, that discussion is hereby adopted and reasserted against the rejection of claim 19.

Porter does nothing to cure the deficiencies of Caccamo and Sugimoto. Porter describes a waterfowl decoy with rotating wings mounted to a floating frame. A pull cord is manually operated by the user to rotate the wings of the decoy. As explicitly stated by Porter, an object of the Porter device is “to provide a waterfowl decoy that moves without the need of a motor” and “where movement may be controlled by a human operator.” (See paragraphs 0015 and 0017)

As with the combination of Caccamo and Sugimoto, it appears that hindsight knowledge of Applicant’s invention has been employed to pick and choose only certain elements of the prior art and then combine and modify those carefully selected elements in a way that leads to something resembling what Applicant is claiming, without regard to what is actually taught or suggested by the references. This is evident from the reasoning given in the Final Office Action. For example, paragraph 3 of the Final Office Action states “. . .it would have been obvious to mount the decoy and housing of Caccamo as modified by Sugimoto on a buoyant housing as shown by Porter to use the unit in water too deep to sink a pipe into the ground.” (Final Office Action, p. 3, lines 18-20) An underlying assumption in this reasoning is that the Caccamo device is limited to shallow water use, but there is no such limitation described in the Caccamo reference. Caccamo describes a flexible arm that is “. . .adapted to have its opposite end anchored in earth or in a length of pipe P.” (Column 2, lines 61-63) Thus, Caccamo teaches that in

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shallow water environments the flexible arm can be anchored directly to earth, and for deep water environments “a length of pipe” can be used to support the flexible arm. There is no limitation, either expressly or implied, with regard to how long Caccamo’s pipe can be.

Another indication that hindsight knowledge of Applicant’s invention has been employed to pick and choose only certain elements of the prior art can be found in the Response To Arguments section of the Final Office Action where it is stated “It should be pointed out that Porter is cited simply to show a buoyant housing.” (Final Office Action, p. 6, lines 19-20) The test for obviousness is what the prior art, taken as a whole, would have suggested to one of ordinary skill in the art. Based on the reasoning provided in the Final Office Action, it appears that Porter’s buoyant housing has been considered in isolation without regard to what Porter and the other references teach “as a whole.” As mentioned above, the object of the Porter device is to provide a waterfowl decoy where movement may be human controlled without the need for a motor. (See paragraphs 0015 and 0017) This express teaching must be taken into account when the prior art is considered as a whole. When the prior art is considered as whole, it can be seen that the bird repelling device of Sugimoto is intended to be “. . . secured to a building.” (Column 2, lines 64-65) In the Background section of the Sugimoto reference, the reference discusses damages to buildings that are caused by nuisance birds. Sugimoto’s device is clearly intended for scaring birds away from buildings. There is no hint or suggestion that it could be used to scare birds away from water, and this is not surprising because one would not normally associate waterfowl’s natural use of a body of water as a nuisance that should be controlled with the use of the Sugimoto device. The prior art,

when considered as a whole, does not teach or suggest the proposed combination and modification of selected elements from the prior art.

For the above reasons, Appellant believes that the references, viewed as a whole, do not teach or suggest the invention defined in claim 19. Claim 19 is therefore believed to be allowable and such action is respectfully requested.

Claims 8-14, 18 and 20

Claims 8-14, 18 and 20 further limit an allowable claim in ways that are neither taught or suggested by the prior art. For example, the prior art does not teach or suggest a buoyant housing to which the claimed force-generating unit is attached (Claims 8 and 18), does not teach or suggest rigid attachment of the claimed rotatable platform to the housing (Claim 9), does not teach or suggest a floatation device operably associated with the buoyant housing for enhancing buoyancy (Claim 10), does not teach or suggest one or more hydrodynamic drag inducing elements attached to an outer surface of the buoyant housing (Claim 11), does not teach or suggest a power supply or a force-generating unit positioned with the buoyant housing (Claims 12 and 13), does not teach or suggest a force-generating unit attached to an outer surface of the buoyant housing (Claim 14), and does not teach or suggest operably associating a floatation device with the claimed buoyant housing (Claim 20).

Thus, Appellant believes that claims 8-14, 18 and 20 are allowable over the prior art, and such action is respectfully requested.

Claims 1-7 and 15-17 are patentable over Sugimoto in view of Caccamo.

The teachings of Sugimoto and Caccamo are discussed at length hereinabove. To avoid repetition, that discussion is hereby adopted and reasserted against the rejection of Claims 1-7 and 15-17.

Claim 1

The Examiner contends that “it would have been obvious to provide the decoy of Sugimoto with arms extending above the platform as shown by Caccamo for the purpose of using the device in locations where a top mount is not practical by mounting the rotatable platform and box from the bottom.” (Final Office Action, p. 4, lines 11-14) Appellant respectfully disagrees. Sugimoto describes several embodiments of his bird-scaring device, including an embodiment where the rotary body and box are mounted from the bottom (See Figure 3). However, there is not embodiment where the raptor decoy is mounted from above. Thus, the motivation provided in the Office Action for combining these two references in the proposed manner is nonexistent. As explained above, the prior art (not the applicant) must provide the motivation to make the proposed modifications needed to arrive at the claimed invention, and there is no such motivation provided by Sugimoto or Caccamo. In fact, these references actually teach away from the proposed combination. In all embodiments, Sugimoto teaches a bird-scaring device that uses a computer-controlled, motorized configuration to fly a raptor decoy at or below the point at which the suspension wire is attached for rotation by the motor. Where is the motivation for Sugimoto to replace the suspension wire and motor-operated raptor decoy with the flexible arm and wind-powered waterfowl decoy of Caccamo? It does not exist, either expressly or implicitly in either of these references. The object of all embodiments

of the Sugimoto device is to scare birds. To transform the Sugimoto bird-scaring device into a bird-luring device, as suggested in the Office Action, would be antithetical to the express teachings of Sugimoto and render it non-functional with respect to its intended purpose. The prior art, when considered as whole, simply does not suggest the combination and modifications that has been proposed by the Examiner.

Even when the Sugimoto and Caccamo devices are combined, the claimed invention does not result. The Sugimoto device teaches use of a suspension wire to fly a raptor decoy at or below the point at which the wire is attached for rotation by the motor. When the raptor decoy of Sugimoto is replaced by the waterfowl decoy of Caccamo, the waterfowl decoy will also fly at or below the point at which the suspension wire is attached for rotation by the motor. This is clearly different than the claimed invention. Waterfowl intended to be lured by such a device will more likely be alarmed or scared because when the decoy is not positioned above the motor attachment point, the motor and other non-luring structure is more readily observable by waterfowl. While this is not a concern in a device that is intended to scare birds, it is certainly a concern for devices that are intended to lure waterfowl (which are easily scared), and neither reference provides any recognition or solution to this problem. Additionally, if the flexible arm and decoy of Caccamo were somehow incorporated into the motorized device described by Sugimoto (and there is no teaching or suggestion whatsoever in either of the references as to why or how this would be done), the result would be a device that scares waterfowl because the decoys of Caccamo are attached to the arms in a way that causes the decoys to pivot about an axis perpendicular to the flexible arm. This would produce a rotating, spinning decoy that is unlike any duck or other waterfowl that Appellant has ever seen

fly. In short, substantial non-obvious modification of the combined teachings of these two references would be required to arrive at Applicant's invention as claimed.

There is a further fatal flaw in the rejection in terms of the combinability of Sugimoto and Caccamo. It is well established in the law governing questions of obviousness that there must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). Otherwise, the combination cannot have been obvious. Here, we have one reference, Caccamo, which employs a simple, passive system that uses wind to animate a decoy for the purpose of luring waterfowl (unlike that claimed by Applicant) combined with another reference, Sugimoto, which employs a complex, active system for the purpose of scaring fowl (also unlike that claimed by Applicant). It is apparent that these two references rely on completely divergent approaches as they attempt to invoke completely different solutions for completely different problems. The considerations involved in scaring birds which dictated the approach employed by Sugimoto are totally unlike the considerations which dictated the approach employed by Caccamo for luring birds.

There is no objectively reasonable basis to assert that the person of ordinary skill attempting to solve the myriad of problems associated with a waterfowl luring apparatus would combine only those elements selected by the Examiner from a passive waterfowl-luring device and an active bird-scaring device. This is especially true when the systems are based on fundamentally different solutions to fundamentally different problems. The reference teachings are simply not "obviously" combinable by any stretch of the

imagination. Given the lack of any express teaching or even an implicit suggestion to combine these two references in the proposed manner, it appears that hindsight knowledge of Applicant's invention has been employed.

For the above reasons, it is apparent that the subject matter of claim 1 defines a patentable advance over the prior art. Allowance of claim 1 is, therefore, respectfully requested.

Claim 16

Claim 16 includes all limitations of Claim 1. To avoid repetition, the above arguments with respect to claim 1 are hereby adopted and reasserted against the rejection of claim 16.

Claim 16 adds to the limitations of claim 1 "wherein each of said support arms is flexible and bends when a decoy is attached to the upper end of the support arm." Although Caccamo teaches attachment of a decoy to a flexible arm, there is no teaching or suggestion to employ the flexible arm of Caccamo into a rotating waterfowl luring apparatus as set forth in claim 16. Claim 16 is therefore allowable over the cited references and such action is respectfully requested.

Claims 2-7, 15 and 17

Turning now to dependent claims 2-7, 15 and 17 each of these dependent claims further limit an allowable claim in ways that are neither taught or suggested by the prior art and are therefore allowable. Accordingly, allowance of claims 2-7, 15 and 17 is respectfully requested.

Claims 8-14 and 18-20 are patentable over Sugimoto in view of Caccamo as applied to claim 1, and further in view of Porter.

Claim 8-14 and 18

Applicant initially notes that neither Sugimoto nor Caccamo, either singly or in combination, teach or suggest a waterfowl luring device as specifically required by independent Claims 1 and 16, from which Claims 8-14 and 18 depend. As discussed above, Sugimoto does not teach or suggest a waterfowl luring device having a waterfowl decoy attached to the upper end of a support arm and positioned above a rotatable platform so that the decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by a force-generating unit, as specifically called for in Claims 1 and 16. Additionally, as discussed above, the teachings of Sugimoto are inapposite to the teachings of Caccamo, and even if one did make the cited combination in the particular manner proposed by the Examiner, the claimed invention does not result. To avoid duplicating all of the above discussion, that discussion is hereby adopted and reasserted against the rejection of Claims 8-14 and 18.

Porter does nothing to cure the deficiencies of Sugimoto and Caccamo. Porter describes a waterfowl decoy with rotating wings mounted to a floating frame. A pull cord is manually operated by the user to rotate the wings of the decoy. The Porter decoy does not teach or suggest a buoyant housing to which the claimed force-generating unit is attached (Claims 8 and 18), does not teach or suggest rigid attachment of the claimed rotatable platform to the housing (Claim 9), does not teach or suggest a floatation device operably associated with the buoyant housing for enhancing buoyancy (Claim 10), does not teach or suggest one or more hydrodynamic drag inducing elements attached to an

outer surface of the buoyant housing (Claim 11), does not teach or suggest a power supply or a force-generating unit positioned with the buoyant housing (Claims 12 and 13), and does not teach or suggest a force-generating unit attached to an outer surface of the buoyant housing (Claim 14). As explicitly stated by Porter, an object of the Porter device is “to provide a waterfowl decoy that moves without the need of a motor” and “where movement may be controlled by a human operator.” (See paragraphs 0015 and 0017)

As with the combination of Sugimoto and Caccamo, the Examiner again appears to have employed impermissible hindsight knowledge of Applicant’s invention to pick and choose only certain elements of the prior art and then combine those carefully selected elements in a way that leads to something resembling what Applicant is claiming, without regard to the explicit teachings of the references. This is evident from the reasoning given in the Office Action. For example, paragraph 5 of the Office Action states “it would have been obvious to provide the decoy of Sugimoto as modified by Caccamo with a floating platform as shown by Porter for the purpose of using the decoys in water too deep to drive a pole into the bottom.” As an initial matter, the bird-luring device of Caccamo does not suggest modification of the bird-scaring device of Sugimoto. And there is nothing in any of the cited references to suggest that Sugimoto should be modified in a way that it can be used in deep water. The Sugimoto device is intended to scare birds away from buildings, and buildings are not normally built in deep water. Porter itself does not even state that the device is intended for use in deep water. Nor is deep water use a stated object of the Porter invention. As explained above, there must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to

combine the elements in the manner proposed by the Examiner so as to create the same invention. Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (D.C.D.C. 1998). In the absence of such an explicit teaching or suggestion, as we have here, the combination cannot be considered obvious. Thus, Claims 1 and 16 are allowable.

Claims 8-14 and 18 further limit an allowable claim in ways that are neither taught or suggested by the prior art and are allowable for this reason as well. Reconsideration and allowance of Claims 8-14 and 18 is, therefore, respectfully requested.

Claim 19

Claim 19 incorporates all of the limitations of Claims 1 and 16 and is therefore allowable for the reasons discussed above. To avoid repetition, that discussion is hereby adopted and asserted against the rejection of Claim 19 over the combination of Sugimoto, Caccamo and Porter.

Claim 19 further requires “a buoyant housing to which said force-generating unit is attached.” Nothing in the cited references teaches or suggests attaching the claimed force-generating unit to a buoyant housing. Porter teaches mounting a human-operated decoy mounted to a floating frame, and specifically teaches away from mounting any type of powered force-generating unit to the unit when he states that an object of the Porter device is “to provide a waterfowl decoy that moves without the need of a motor” and “where movement may be controlled by a human operator.” (See paragraphs 0015 and 0017) Caccamo also teaches away from the use of a powered force-generating unit when he states that the principal object of the Caccamo device is “the provision of a simple yet effective means for mounting a conventional and existing decoy in a manner

to achieve animated action thereof in accordance with various wind conditions.” (See column 1, lines 47-51) Modification of the Caccamo and Porter devices in the proposed manner would be antithetical to the wind-powered and human-powered solutions taught by these references.

For all the above reasons, Claim 19 is allowable over the cited combination and such action is respectfully requested.

Claim 20

Claim 20 further limits an allowable claim in a way that is neither taught or suggested by the prior art. There is no teaching or suggestion whatsoever of operably associating a floatation device with the claimed buoyant housing. Reconsideration and allowance of Claim 20, therefore, is respectfully requested.

CONCLUSION

Appellant’s specification describes a uniquely configured, mechanized waterfowl luring system that provides active, directional movement of waterfowl decoys with unprecedented results. The fact that individual elements of Appellant’s invention can be found in the disparate prior art references relied upon in the Final Office Action is not dispositive of the obviousness issue. It is well established that the prior art must be considered as a whole. Appellant believes that when the invention as claimed is viewed in light of what these references teach and suggest as a whole, it is clear that one of ordinary skill would not have been motivated to combine and modify the various elements of the references in the proposed manner without some kind of additional

motivating force, such as inventive thought or hindsight knowledge of Appellant's invention.

Reversal of the rejection of all claims is, therefore, respectfully requested.

VIII. CLAIMS APPENDIX (37 C.F.R. 41.37(c)(1)(viii))

The text of the claims involved in the appeal are:

1. An apparatus for luring waterfowl, the apparatus comprising:
 - a rotatable platform;
 - a force-generating unit for rotating the rotatable platform;
 - a power source for powering the force-generating unit to rotate the rotatable platform;
 - one or more support arms attached to the rotatable platform, each of said support arms including:
 - a lower end attached to the rotatable platform; and
 - an upper end positioned above the rotatable platform; and
 - a waterfowl decoy attached to the upper end of each support arm with said decoy being positioned above the rotatable platform;
 - wherein each decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, thereby providing a lure for waterfowl.
2. The apparatus of claim 1 wherein said force-generating unit includes an electric motor with an output shaft attached to the rotatable platform.
3. The apparatus of claim 1 wherein said force-generating unit includes a jet propulsion device.
4. The apparatus of claim 1 wherein said power source includes a battery.
5. The apparatus of claim 1 wherein each of said support arms includes an elongate rod having a substantially circular cross-sectional dimension.
6. The apparatus of claim 1 wherein each of said support arms is flexible and bends when a decoy is attached to the upper end of the support arm.

7. The apparatus of claim 1 wherein said waterfowl decoy includes a body portion with wings spread and extending from opposed sides of the body portion so as to simulate flight.
8. The apparatus of claim 1, further comprising a buoyant housing to which said force-generating unit is attached.
9. The apparatus of claim 8 wherein said rotatable platform is rigidly attached to the housing.
10. The apparatus of claim 8, further comprising a floatation device operably associated with the buoyant housing for enhancing buoyancy of the apparatus.
11. The apparatus of claim 8, further comprising one or more hydrodynamic drag inducing elements attached to an outer surface of the buoyant housing.
12. The apparatus of claim 8 wherein said power supply is positioned within the buoyant housing.
13. The apparatus of claim 12 wherein said force-generating unit is positioned within the buoyant housing.
14. The apparatus of claim 12 wherein said force-generating unit is attached to an outer surface of the buoyant housing.
15. The apparatus of claim 1, further comprising a controller for controlling operation of the force-generating unit.

16. An apparatus for luring waterfowl, the apparatus comprising:
 - a rotatable platform;
 - a force-generating unit for rotating the rotatable platform;
 - a power source for powering the force-generating unit to rotate the rotatable platform;
 - one or more support arms attached to the rotatable platform, each of said support arms including:
 - a lower end attached to the rotatable platform; and
 - an upper end positioned above the rotatable platform;
 - wherein each of said support arms is flexible and bends when a decoy is attached to the upper end of the support arm; and
 - a waterfowl decoy attached to the upper end of each support arm with said decoy being positioned above the rotatable platform;
 - wherein each decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, thereby providing a lure for waterfowl.
17. The apparatus of claim 16 wherein said waterfowl decoy includes a body portion with wings spread and extending from opposed sides of the body portion so as to simulate flight.
18. The apparatus of claim 16, further comprising a buoyant housing to which said force-generating unit is attached.

19. An apparatus for luring waterfowl, the apparatus comprising:
- a rotatable platform;
 - a force-generating unit for rotating the rotatable platform;
 - a buoyant housing to which said force-generating unit is attached;
 - a power source for powering the force-generating unit to rotate the rotatable platform;
- one or more support arms attached to the rotatable platform, each of said support arms including:
- a lower end attached to the rotatable platform; and
 - an upper end positioned above the rotatable platform;
- wherein each of said support arms is flexible and bends when a decoy is attached to the upper end of the support arm; and
- a waterfowl decoy attached to the upper end of each support arm with said decoy being positioned above the rotatable platform;
- wherein each decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, thereby providing a lure for waterfowl.
20. The apparatus of claim 19, further comprising a floatation device operably associated with the buoyant housing for enhancing buoyancy of the apparatus.

IX. EVIDENCE APPENDIX

Not applicable.

X. RELATED PROCEEDINGS APPENDIX

Not applicable.

Respectfully submitted,

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